

Attorney's Docket No. 042933/302586

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Mika Gronroos
Appl. No.: ~~09/736,927~~ 09/376,927
Filed: August 18, 1999
For: RECREATIONAL REWARD-RELATED APPARATUS, AND ASSOCIATED
METHOD, FOR REWARDING PERFORMANCE OF EXECUTION OF A
RECREATION APPLICATION AT A MOBILE TERMINAL

Confirmation No.: 7122

Group Art Unit: 2685

Examiner: Gesesse, Tilahun

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

FAX RECEIVED

MAR 06 2006

OFFICE OF PETITIONS

INFORMATION DISCLOSURE STATEMENT
UNDER 37 C.F.R. § 1.97(b)(4)

Attached is a list of documents on form PTO-1449 along with a copy of any cited foreign patent documents and non-patent literature documents in accordance with 37 CFR 1.98(a)(2). Also attached is a copy of an Official Communication from the European Patent Office which discusses the two documents listed on the attached form PTO-1449.

It is requested that the Examiner consider these documents and officially make them of record in accordance with the provisions of 37 C.F.R. § 1.97 and Section 609 of the MPEP. By identifying the listed documents, Applicant in no way makes any admission as to the prior art status of the listed documents, but is instead identifying the listed documents for the sake of full disclosure.

CUSTOMER NO. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

Respectfully submitted,



Brian J. Teague
Registration No. 55,670

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at
Fax No. (571) 273-0025 on the date shown below.


Tamara Stevens

3-6-2006
Date



☐ EPA/EPO/EEB
D-80299 München

☎ +49 89 2399-0
TX 523 656 epmu d
FAX +49 89 2399-4465

Europäisches
Patentamt

Generaldirektion 2

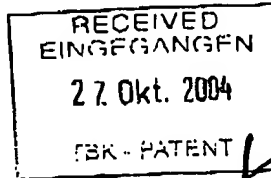
European
Patent Office

Directorat Général 2

Office européen
des brevets

Direction Générale 2

Leson, Thomas Johannes Alois, Dipl.-Ing.
Patentanwält
Tiedtke-Bühling-Kinne & Partner,
Bavariaring 4
80396 München
ALLEMAGNE



Telephone numbers:

Primary Examiner (substantive examination) +49 89 2399-7787

Formalities Officer / Assistant (Formalities and other matters) +49 89 2399-7574



Application No. 00 113 826.2 - 2211	Ref. EP 27453	Date 26.10.2004
Applicant Nokia Corporation		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

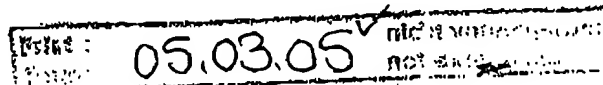
You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).




W 5.12.

ROSS C R
Primary Examiner
for the Examining Division

Enclosure(s): 6 page/s reasons (Form 2906)

Registered Letter

	Beschaid/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
	Datum Date 26.10.2004	Blatt Sheet Feuille 1	Anmelde-Nr.: Application No.: Demande n°: 00 113 826.2

The examination is being carried out on the following application documents:

Text for the Contracting States:

AT BE CH CY DE DK ES FI FR GB GR IE IT LU MC NL PT SE LI

Description, pages:

1-17 as originally filed

Claims, No.:

1-20 as originally filed

Drawings, sheets:

1/8-8/8 as originally filed

- 1 The following documents (D) are referred to in this communication; the numbering will be adhered to in the rest of the procedure:

D1: DE-A-19610840

D2: US-A-5120076

- 2 The application is not allowable because claims 2, 4, 7, 8, and 10-12 are not clear in the sense of Article 84 EPC.
- 2.1 Claims 2 and 4 are not clear because the terminology used has a special meaning according to the description, this special meaning differing from the generally accepted meaning of the terms. According to the description on page 10, second full paragraph, the term "actuator" - in particular concerning the uncommon combination "user actuator" - has a special meaning within the scope of this application, deviating from the normal meaning of this term. Clarification is required by adding the above-mentioned definition in the description to the claims.
- 2.2 Apparatus claims 7 and 8 are not clear because they includes method steps ("said detector detects", claim 7; "said formatter formats", claim 8). This casts doubt on



Beschuld/Protokoll (Anlage)

Communication/Minutes (Annex)

Notification/Procès-verbal (Annexe)

Datum
Date 26.10.2004

Blatt
Sheet 2
Feuille

Anmalse-Nr.:
Application No.: 00 113 826.2
Demande n°:

the category of the claims. Clarification is required (see the EPO Examination guidelines C-III 4.1).

- 2.3 The scope of claims 10 and 11 is not clear because they contain subject-matter related to other entities which are not part of the mobile terminal apparatus claimed. For claim 10, this concerns the "response-message" and for claim 11 the "reward". Clarification is required (Guidelines C-III 4.8a).
- 2.4 Claim 12 is not clear because no mention is made of the fact that the method steps are performed on the mobile terminal (including detecting whether the indicia is higher than the threshold). Furthermore, since the description (see for example page 13, lines 22-26) only indicates that the method steps of the claim are to be performed by the mobile terminal, the broader definition of the claim is not supported and therefore not allowable (Guidelines C-III 6.5).
- 3 The present application does not meet the requirements of Article 52(1) EPC, because the subject-matter of claims 1, 12 and 16 does not involve an inventive step in the sense of Article 56 EPC.
- 3.1 Document D1, which is considered to represent the most relevant state of the art, describes the use of a mobile phone for playing games, interacting with a server in a typical GSM environment comparable to that of the application (first embodiment).

Document D1 discloses, using the terminology of claim 1,

An apparatus for a mobile terminal operable by a user in a radio communication system to communicate with a communication station by way of a communication path which includes a radio part, (see D1, figure 1 with column 4, lines 29-34) said apparatus comprising:

at least one executable block of code executable by the user at the mobile terminal (see D1, column 2, lines 15-18);

a formatter coupled to receive the result indication generated by said detector, said formatter for formatting the result indication into a signal transmitta-



Bescheld/Protokoll (Anlage)

Communication/Minutes (Annex)

Notification/Procès-verbal (Annexe)

 Datum
 Date 26.10.2004
 Date

 Blatt
 Sheet 3
 Feuille

 Anmelde-Nr.:
 Application No.: 00 113 826.2
 Demande n°:

ble upon the communication path (see D1, column 5, lines 42-45, 48-49).

The subject-matter of claim 1 differs from the disclosure in D1 in that the mobile terminal further includes (based on the wording of the claim),

on execution of said executable block of code the generation of at least an indicia of performance success of the execution by the user of the executable block of code;

and a detector coupled to receive indications of the indicia of performance success generated during execution of the executable block of code, said detector at least for detecting whether the indicia of performance is beyond a selected threshold and for selectively generating a result indication indicative thereof.

The problem to be solved by the present invention may therefore be regarded as finding a way of adding high-score notification functionality to the system disclosed in D1.

However, this problem is already solved in the same way as in the application (by comparing with a threshold) in document D2 (see D2, column 3, last full sentence (scoring) and column 4 lines 63-64 (high-score determination) with column 5, first full sentence (notification)).

The skilled person would combine the solution of D2 with the closest prior art (D1) to arrive at the invention of the application, without inventive skill since both disclosures address playing games in a distributed environment i.e. with remote players and central resources.

Therefore, the subject-matter of claim 1 does not involve an inventive step (Article 56 EPC). Consequently, claim 1 is not allowable according to Article 52(1) EPC.

3.2 Claim 12 is a representation of apparatus claim 1 in terms of a system. Therefore, the arguments brought forward for claim 1 similarly apply to claim 12. Consequently, the subject-matter of claim 12 does not involve an inventive step (Article



Bescheld/Protokoll (Anlage)

Communication/Minutes (Annex)

Notification/Procès-verbal (Annexe)

Datum
Date
Date

26.10.2004

Blatt
Sheet
Feuille

4

Anmelde-Nr.:
Application No.: 00 113 826.2
Demanda n°:

56 EPC), making claim 12 not allowable according to article 52(1) EPC.

3.3 The subject-matter of claim 16 covers the corresponding server. Document D1 discloses, using the terminology of claim 16,

an apparatus for an award server operable in a communication system to communicate with a mobile terminal by way of a communication system to communicate with a mobile terminal by way of a communication path which includes a radio part (see D1, column 4, lines 29-31), said apparatus comprising:

a result-indication signal receiver coupled to receive indications of a result-indication signal communicated to the award server by the mobile terminal (see D1, column 5, lines 42-49);


an database having result data, said database accessible at least responsive to receipt of said result-indication signal receiver of the result-indication signal (see D1, column 4, lines 58-61); and

a signal generator selectably operable responsive to data accessed from said database, said signal generator for generating a signal for communication to the mobile terminal, the signal responsive at least alternately to one of the result-indication signal and values stored in said database (see D1, sentence bridging columns 5 and 6).

The subject-matter of claim 16 differs from the disclosure in D1 in that within the communication between mobile terminal and server instead of the choice of game a high-score is communicated, and instead of a game program a reward is returned, respectively.

For the skilled person it is an obvious design procedure to modify - in the light of document D2 - the server disclosed in D1 to provide the necessary award issuing functionality as a response to the receipt of high-score messages.

Therefore, the subject-matter of claim 16 does not involve an inventive step (Article 56 EPC). Consequently, claim 16 is not allowable according to Article

	Bescheid/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
	Datum Date 26.10.2004	Blatt Sheet Feuille 5	Anmelde-Nr.: Application No.: Demande n°: 00 113 826.2

52(1) EPC.

- 4 The dependent claims do not contain additional features that would lead to patentable subject-matter, because their subject-matter does not involve an inventive step in the sense of Article 56 EPC.
- 4.1 The additional features of claims 2-4, defining various ways of user influence, are already disclosed in D1 (see column 1, lines 45-46 or column 5, lines 11-17).
- 4.2 As for claim 5, which introduces the recreational aspect of the application, both disclosures D1 and D2 are explicitly applied in the field of gaming.
- 4.3 Claim 6 relates to scoring the game, which is already disclosed in D2 (column 4, last full sentence).
- 4.4 Claim 7 relates to a feature already included in claim 1, this feature applied with respect to the game score. As argued for claim 1, even this refinement is already disclosed in D2 (column 4, lines 62-63).
- 4.5 Claims 8, 9 and 17 concern the use of SMS for communication, which however is already disclosed in D1 (column 5, lines 52-56 or column 6, lines 4-8).
- 4.6 The argument for claim 16 similarly holds for claim 10.
- 4.7 Concerning claims 11, 15 and 18-20, their subject-matter (ring-tones as award, reward depending on score and other data in database, cumulating scores) relates to mere choices among known possibilities, and a skilled person would make the choice according to the situation without exertion of inventive skill. See the Guidelines C-IV-Annex, 2.1.
- 4.8 The subject-matter of claims 13 and 14 is already disclosed in both D1 (column 5, lines 42-48) and D2 (column 5, lines 1-4).
- 5 It is not at present apparent which part of the application could serve as a basis for a new, allowable claim. Should the applicant nevertheless regard some



Bescheld/Protokoll (Anlage)

Communication/Minutes (Annex)

Notification/Procès-verbal (Annexe)

Datum
Date
Date

26.10.2004

Blatt
Sheet
Feuille

6

Anmaka-Nr.:
Application No.: 00 113 826.2
Demande n°:

particular matter as patentable, an independent claim should be filed taking account of Rule 29(1) EPC: the features known from the prior art (document D1) should be put into the preamble (Rule 29 (1) (a) EPC).

- 5.1 The applicant should also indicate in the letter of reply the difference of the subject-matter of the new claim vis-à-vis the state of the art (in particular documents D1 and D2) and the significance thereof.
- 5.2 The features of the claims should be provided with reference signs placed in parentheses to increase the intelligibility of the claims (Rule 29(7) EPC). This applies to both the preamble and characterising portion (see the Guidelines, C-III, 4.11).
- 5.3 When filing amended claims the applicant should at the same time bring the description into conformity with the amended claims (Rule 27(1)(c) EPC).
- 5.4 To meet the requirements of Rule 27(1)(b) EPC, the documents D1 and D2 should be identified in the description and the relevant background art disclosed therein should be briefly discussed.

Furthermore, following from the disclosures of documents D1 and D2, the statement indicating the technical problem to be solved requires revision which should be done taking the requirements of Rule 27 (1) (c) EPC into account (see also Guidelines, C-II, 4.5).

- 5.5 Care should be taken during revision, especially of the introductory portion and any statements of problem or advantage, not to add subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC).

In order to facilitate the examination of the conformity of the amended application with the requirements of Article 123(2) EPC, the applicant is requested to clearly identify the amendments carried out, irrespective of whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based (see EPO Examination Guidelines, E-II, 1).